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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/163,588 09/30/98 JONES

M 050701-1028

EXAMINER

LOUIS JACQUES, J

ART UNIT	PAPER NUMBER
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3661

DATE MAILED:

03/29/00

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PM82/0329

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/163,588

Applicant(s)

JONES, MARTIN KELLY

Examiner

Jacques H. Louis-Jacques

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed November 15, 1999 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

More particularly, Document AO has not been considered.

It appears that IDS filed on November 15, 1999 is a duplication of the IDS filed on December 28, 1998 with the exception that the IDS filed on 12/28/98 includes patent No. RE 35,920. To avoid any printing error if this application were to become allowed, the IDS filed on 11/15/99 has been fully considered and the references has been initialed. However, in the IDS filed on 12/28/98 only document BX, US Patent No. Re 35,990 has been considered. To avoid any confusion, the other references in the 12/28/98 IDS have been crossed out.

Drawings

2. The drawings filed on September 30, 1998 have been approved by the draftsperson.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-40 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5. Claims 1-40 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-36 of copending Application No. 09/163,958. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

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6. Claims 1-36 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-21, 23-49 of copending Application No. 08/852,119. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on those copending applications since the referenced copending applications and the instant application are claiming common subject matter, as follows: A method for monitoring travel of vehicles and for reporting status of vehicles based on travel data related to the vehicles.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. Claims 1-40 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,623,260 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

8. Claims 1-40 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 5,657,010 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

9. Claims 1-40 are rejected under the judicially created doctrine of double patenting over claims 1-80 of U. S. Patent No. 5,668,543 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patents and is covered by the patents since the patents and the application are claiming common subject matter, as follows: An advance notification system and method utilizing passenger calling report generator.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross [5,648,778].

Ross '770 discloses an apparatus and method of notifying a party of a pending delivery or pickup. A mobile receiver or carrier is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or

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position to the location in the mapped area. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). Ross '770 also discloses a storage device for storing travel data related to the vehicle. The storage device is mounted on the vehicle located at a remote location. There is also provided a communications device or apparatus for transmitting a message to a controller located at another remote location. The received or transmitted message is indicative of the status (proximity) of the vehicle. As disclosed in column 2, there is provided an analyzer for evaluating the positioning signals to determine the position of the carrier, the position of the carrier is compared with a predetermined location. Also, a time interval is computed, and when the time interval is less than a predetermined time interval, a signal is communication to provide reasonable advance notice. See column 2. Also, a message or notification is forwarded to user via a telephone associated therewith. See columns 5 and 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing an audible message to notify the party. Ross discloses the time period, and the predetermined distance as the data representative of the proximity of the vehicle. In column 3, Ross '770 discloses the cellular network as a communications device. Further in column 3, Ross '700 discloses the vehicle indicator (identification) and the location indicator. Still in column 3, Ross '770 discloses the communication interface as being telephone interface devices. As an alternate embodiment of the Ross patent, the vehicle can bus a bus and the location indicator is a bus stop. See column 6.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,155,689	Wortham	Oct. 1992
5,398,190	Wortham	Mar. 1995
5,432,841	Rimer	Jul. 1995
5,719,771	Buck et al.	Feb. 1998
5,796,365	Lewis	Aug. 1998
5,922,040	Prabhakaran	Jul. 1999

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is (703) 305-9757. The examiner can normally be reached on M-Th, 8:30 AM - 5:00 PM (Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-8623 for regular communications and (703) 308-8623 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1111.

Jacques H. Louis-Jacques
Primary Examiner
Art Unit 3661

/jlj
March 22, 2000

Jacques Louis Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER